

### REMARKS

The Examiner has rejected Claim 6 under 35 U.S.C. Section 112, second paragraph, as being indefinite. To further prosecution, and without comment as to the propriety of the rejection, Applicants have canceled the claim, without prejudice. Claim 12 has been added and finds support throughout the specification, including, for instance, at page 23, lines 12-17.

The Examiner has rejected Claims 1, 5 and 7-11 under 35 U.S.C. Section 103(a) as being unpatentable over the disclosure of U.S. Patent 5,709,870 issued to Yoshimura, et al. ("Yoshimura"), in view of the disclosure of U.S. Patent 6,468,521 issued to Pedersen, et al. ("Pedersen"). For the reasons which follow, Applicants respectfully traverse the rejection.

Yoshimura discloses a silver containing antimicrobial agent comprising carboxymethyl cellulose, which may be a cross-linked polymer to make the agent water resistant (Abstract).

As the Examiner notes, Yoshimura fails to disclose the agent comprising a water-soluble protein. (Office Action, p. 3)

Pedersen discloses a silver compound with antibacterial, antiviral or antifungal activity, in the form of a complex with an amine moiety associated to one or more hydrophilic polymers, which may include gelatin (See Pedersen Abstract, see also Pedersen claim 5).

The Examiner contends that Yoshimura discloses a silver containing anti-microbial agent, but does not teach the agent as comprising a water soluble protein. The Examiner further contends that Pedersen teaches a silver compound that can be cross-linked with gelatin to form a hydrophilic polymer.

Based on the above contentions, the Examiner maintains that it would have been obvious to one of ordinary skill in the art to combine the antimicrobial agent of Yoshimura with the

hydrophilic polymer of Pedersen, "because Yoshimura teaches that an antimicrobial agent which has water resistance and maintains antimicrobial properties in a water contacting environment is an object of the invention." (Office Action, p. 4)

The rejection is clearly improper as the Examiner has failed to account for a protein containing 0.1 to 200 micro-moles of active thiol group per gram. Indeed, as will be shown, Yoshimura discloses no active thiol groups, and Pedersen specifically teaches away from using thiosulfates with the water-soluble protein disclosed. These deficiencies are fatal to the rejection because, and as the Examiner well knows, to maintain a *prima facie* rejection based on obviousness, all elements and limitations of the claims must be present in the cited art. In order to establish a *prima facie* case of obviousness, i.e. the cited references must teach every element recited in the claims. In re Rouffet, 149 F. 3d 1350; 47 USPQ2d 1453 (Fed. Cir., 1998). All properties and attributes must be considered by the Examiner. In re Antonie, 195 USPQ6 (CCPA 1977). In issuing the rejection, the Examiner has clearly not considered all properties and elements of the claims under rejection.

Yoshimura discloses ammonium thiocyanate used in titration measurement of the silver content, but does not disclose active thiol groups in the cross-linked CMC(Ag) product, which is the product the Examiner contends would be modified according to the teachings of Pedersen. This deficiency in Yoshimura is in addition to the fact that it does not disclose combination with a water soluble protein, which the Examiner admits.

Pedersen affirmatively teaches away from incorporating thiol groups where it prefers stabilization of the silver salt with amines, stating that inclusion of thiosulfates would render the complex unstable in the presence of the hydrophilic polymers disclosed, see Column 3, lines 45-52. As a result, and in view of what Applicants have claimed, Pedersen does nothing to fill the gaps in

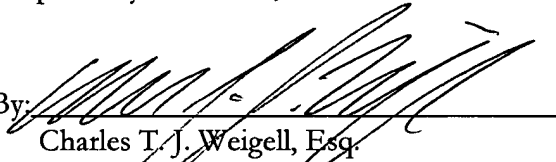
the disclosure of Yoshimura, nor does it teach, suggest or motivate one of skill in the art to modify Yoshimura to so arrive at that Applicants have claimed.

Applicant therefore respectfully submits that the citations fail not only to disclose or teach each element of the Applicants' claims, but also fail to provide the requisite suggestion *to do* what the Applicants have done. For these reasons alone, the rejection of the claims is insufficient as a matter of law. Ex parte Levengood, 28 USPQ2d 1300, 1301-02 (BPAI 1993). Reconsideration and withdrawal of the rejection is respectfully solicited.

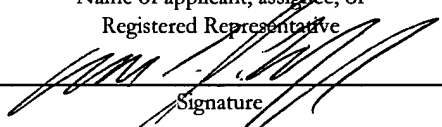
### CONCLUSION

In view of the foregoing, favorable action on the merits, and allowance of all claims, respectfully is solicited.

Respectfully submitted,

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